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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/540,756	03/31/2000	Laura L. Mahan	81395-157	3424

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EXAMINER

VAUGHN, GREGORY J

ART UNIT	PAPER NUMBER
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2178

DATE MAILED: 04/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/540,756

Applicant(s)

MAHAN ET AL.

Examiner

Gregory J. Vaughn

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 27 January 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8, 14-26 and 33-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8, 14-26 and 33-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date: _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Application History

1. This action is responsive to the application amendment, application amendment filed on 1/27/2004.
2. Applicant has amended the disclosure in response to the objections cited by the examiner in the *Drawings* and *Specification* sections of the previous office action (dated 10/27/2003). Applicant's amendment has addressed all objections previously made, and therefore, in view of this amendment, objections to the drawings and specification are withdrawn.
3. Applicant has amended the claims as follows: claims 9-13 and 27-32 are canceled; claims 1, 14-17 and 25 are amended; claims 33-36 are added.
4. Claims 1-8, 14-26 and 33-36 are pending in the case, claims 1, 14, 15, 16 and 17 are independent claims.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

"The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention. "
6. Claims 35 and 36 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
7. **Regarding claim 35**, the claim recites the limitation "*The apparatus claimed in claim 1*" in first line of the claim. There is insufficient antecedent basis for this limitation in the claim. Claim 1 is directed toward a "*method*".
8. **Regarding claim 36**, the claim recites the limitation "*The apparatus claimed in claim 3*" in first line of the claim. There is insufficient antecedent basis for this limitation in the claim. Claim 3 is directed toward a "*method*".

Double Patenting

9. Claim 35 and 36 are objected to under 37 CFR 1.75 as being substantial duplicates of claims 33 and 34 (respectively). When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

"A person shall be entitled to a patent unless –

(e) The invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language."

11. Claims 1-3, 6-8, 14-19, and 22-26 remain rejected under 35 U.S.C. 102(e) as being anticipated by Gill et al. US Patent 6,081,262 (filed 12/4/1996, patented 6/27/2000). "Gill et al." is hereafter referred to as "Gill".
12. **Regarding independent claim 1**, and in reference to the first limitation of the claim, Gill recites: *"The multi-media presentation generation system comprises a menu driven multi-media presentation generation system MPG, executing on a processor P, which accesses data from any of a multitude of media sources S1-S6"* (column 5, lines 10-15). Gill further recites: *"The multi-media presentation generation system MPG also comprises a software extension feature QC which functions to interconnect the page based document layout system Q with at least one source of media objects S1-S6"* (column 5, lines 41-44), where Gill defines media objects as:

"external sources including, but not limited to, data communication connections to broadcast media, such as Internet S4" (column 6, lines 3-5).

Regarding the second and third limitations of the claim, Gill recites: *"the author defines a movie object MB into which is imported a movie, which is stored in memory, and obtained from one of the sources named above" (column 10, lines 11-13).* Gill discloses a concurrent presentation window for previews in Figure 2 at reference sign MB.

13. **Regarding dependent claim 2,** Gill recites: *"Since the multi-media data is stored and processed by the page based document layout system Q in a transparent manner" (column 15, lines 49-51).*

14. **Regarding dependent claim 3,** Gill recites: *"The multi-media authoring tool assigns a unique identification to each object that has multi-media information and that is located in the multi-media presentation" (column 4, lines 12-14).*

15. **Regarding dependent claim 6,** Gill recites: *"The author must populate each of the individual frames with the selected video, graphical, and textual material" (column 1, lines 34-36).*

16. **Regarding dependent claim 7,** Gill recites: *"for multi-media content, with the hidden information which defines the multi-media content" (column 7, lines 28-30).* Gill also recites: *"The author also defines a path PL ... The path PL represents a motion definition for a object having some content, which object is tied to the path" (column 10, lines 21-26).*

17. **Regarding dependent claim 8**, the claim contains substantially the same subject matter as claims 3 and 7 combined, and is rejected with the same rational.
18. **Regarding independent claims 14, 15, 16 and 17**, the claims contains substantially the same subject matter as claim 1 and are rejected with the same rational.
19. **Regarding dependent claim 18**, the claim contains substantially the same subject matter as claim 2 and is rejected with the same rational.
20. **Regarding dependent claim 19**, the claim contains substantially the same subject matter as claim 3 and is rejected with the same rational.
21. **Regarding dependent claim 22**, the claim contains substantially the same subject matter as claim 6 and is rejected with the same rational.
22. **Regarding dependent claim 23**, the claim contains substantially the same subject matter as claim 7 and is rejected with the same rational.
23. **Regarding dependent claim 24**, the claim contains substantially the same subject matter as claim 8 and is rejected with the same rational.
24. **Regarding dependent claim 25**, the claim contains substantially the same subject matter as claim 1 and is rejected with the same rational.
25. **Regarding dependent claim 26**, the claim contains substantially the same subject matter as claim 1 and is rejected with the same rational.

26. New claims 33 and 35 are rejected under 35 U.S.C. 102(e) as being anticipated by Gill.
27. **Regarding dependent claim 33**, Gill recites: *"The underlying page based document layout system is a menu based system which functions to partition document pages, as defined by the author, into a plurality of objects (also termed boxes), each of which is independently editable by the author"* (column 6, lines 23-27). As noted above, Gill discloses a concurrent presentation window for previews in Figure 2 at reference sign MB.
28. **Regarding dependent claim 35**, the claim contains substantially the same subject matter as claim 33 and is rejected with the same rational.

Claim Rejections - 35 USC § 103

29. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

"(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made."

30. Claim 4, 5, 20 and 21 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Gill in view of Fields et al. US Patent 6,128,655 (filed 7/10/1998, patented 10/3/2000). "*Fields et al.*" is hereafter referred to as "*Fields*".

31. **Regarding dependent claim 4**, the claim is directed toward using a uniform resource locator (URL) as an identifier. Gill discloses the use of an identifier for the multimedia content. Gill fails to disclose the use of URLs as identifiers. Fields teaches that a URL can be used as an identifier. Fields recites: "*In the Internet paradigm, a network path to a server is identified by a so-called Uniform Resource Locator (URL)*" (column 1, lines 17-19).

Therefore, it would have been obvious, to one of ordinary skill in the art, at the time the invention was made, to use URLs as identifiers to Internet multimedia content because URLs uniquely identify all internet content.

32. **Regarding dependent claim 5**, the claim is directed toward using a uniform resource locator (URL) as an identifier while said multimedia content is in use by an

application. The limitations of this claim contain substantially the same subject matter as claims 1 and 4 combined, and are rejected with the same rational.

33. **Regarding dependent claim 20**, the claim contains substantially the same subject matter as claim 4, and is rejected with the same rational.

34. **Regarding dependent claim 21**, the claim contains substantially the same subject matter as claim 5, and is rejected with the same rational.

35. Claim 34 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gill in view of Fields.

36. **Regarding dependent claim 34**, Gill discloses the use of an identifier as described above. Gill fails to disclose displaying the identifier. Fields teaches displaying identifier information. Fields discloses in Figure 3A, the media identifier (shown as "<http://www.ibm.com/Services/pressrel/pr.890622721.html>") displayed with the media information (shown at reference sign 203).

Therefore, it would have been obvious, to one of ordinary skill in the art, at the time the invention was made, to combine the multimedia authoring system of Gill with the displayed identifiers as taught by Fields in order to allow presentation viewers the capability to view media material source identifiers.

37. **Regarding dependent claim 36**, the claim contains substantially the same subject matter as claim 34, and is rejected with the same rational.

Response to Arguments

38. Applicant's arguments filed 1/27/2004 have been fully considered but they are not persuasive.
39. **Regarding independent claim 1**, the applicant states: "*Gill et al. fail to disclose or suggest a method of building a presentation ... as recited in amended claim 1*" (page 19, second paragraph). The applicant is directed to the rejection of amended claim 1 as stated above. Gill recites: "*The multi-media presentation generation system MPG also comprises a software extension feature QC which functions to interconnect the page based document layout system Q with at least one source of media objects S1-S6*" (column 5, lines 41-44), where Gill defines media objects as: "*external sources including, but not limited to, data communication connections to broadcast media, such as Internet S4*" (column 6, lines 3-5). Gill further recites: "*the author defines a movie object MB into which is imported a movie, which is stored in memory, and obtained from one of the sources named above*" (column 10, lines 11-13). Gill discloses a concurrent presentation window for previews in Figure 2 at reference sign MB. Related independent claims 14, 15, 16 and 17 are rejected for similar reasons.
40. **Regarding dependent claims 2-8 and 18-26**, the applicant states "*The rejection as it relates to claims 2-3 and 6-8 which ultimately depend from amended claim 1 is overcome by the amendments to claim 1 ... The rejection as it relates to claims 18-19 and 22-26 which ultimately depend from amended claim 17 is overcome by the*

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amendments to claim 17" (page 19, third paragraph) and "Claims 4-5 ultimately depend from amended claim 1 ... neither discloses or suggested by Fields et al. and is therefore not obvious and therefore the combination claimed in claims 4-5 is also not obvious. Claims 20-21 ultimately depend from amended claim 17 ... neither discloses or suggested by Fields et al. and is therefore not obvious and therefore the combination claimed in claims 20-21 is also not obvious" (page 20, second and third paragraphs). Applicant is directed to the rejection of dependent claims 2-8, and 18-26 as restated above.


Conclusion

41. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).
42. A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.
43. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory J. Vaughn whose telephone number is (703) 305-4672. The examiner can normally be reached Monday to Friday from 8:00 am to 5:00 pm.
- If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather R. Herndon can be reached at (703) 308-5186. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Gregory J. Vaughn
March 23, 2004



STEPHEN S. HONG
PRIMARY EXAMINER